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Gordon T. Brown

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EXAMINER

SHRESTHA, BIJENDRA K

ART UNIT

PAPER NUMBER

3691

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/975,458	<b>Applicant(s)</b> BROWN, GORDON T.	
	<b>Examiner</b> BIJENDRA K. SHRESTHA	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 28-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/19/2002, 02/27/2003, 12/22/2003, 10/29/2004</u>            | 6) <input type="checkbox"/> Other: _____                          |
| <u>and 10/07/2005</u>  |   |



### **DETAILED ACTION**

In view of the Appeal Brief filed on 08/19/2005, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Alexander Kalinowski/

Supervisor Patent Examiner, 3691

### ***Priority***

Acknowledgement is made that application is a CON of application 08/975,458 09/28/1994 abandoned.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 28 and 35-50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 14-17 and 21-27 of copending Application No. 09/975,457. Although the conflicting claims are not identical, they are not patentably distinct from each other because '457 application claims 1-7, 14-17 and 21-27 teach all the elements in claims 28 and 35-50 in the instant application.

*This is a provisional double patenting rejection since the conflicting claims have not yet been patented.*

As per Claims 28 and 35-50 of instant application, claims 1-7, 14-17 and 21-27 of applications '457 teach method for providing automated accounting system for an entity that include establishing a file for the entity, providing data inputs and providing access to data file for performing the transactions. Claims 35-44 of instant application is similar to claims 2-7 and 14-17 respectively of the application '457. Similarly claims 45-50 is similar to claims 21-27 of the application '457.

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2. Claims 28, 35-51 and 67-69 are rejected on the ground of nonstatutory double patenting over claims 1-18 of U. S. Patent No. 5,875,435 *since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.*

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: *a method for providing financial accounting reports statements for entity comprising a menu of standardized codes, conducting separate financial transaction, associating standardized codes, sorting transaction and generating accounting reports.*

As per claims 28, 51 and 69, claims 1 of patent '435 teach a method for providing financial accounting reports statements for entity comprising a menu of standardized codes, conducting separate financial transaction, associating standardized codes, sorting transaction and generating accounting reports. Claims 35-44 of instant application is similar to claims 2-11 of the patent '435.

As per claims 45, 59 and 67-69, claims 12-13 of patent '435 teach first computer (financial accounting computer), second computer (financial transaction computer), transferring data between the computers and providing access to perform one or more activities. Claims 46-50 in instant application is similar to claims 14-18 of the patent '435.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 28-44, 51-54, 63-66 and 70 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 28-44 and 51-54, as best understood, it appears that the claimed method steps could simply be performed by mental process alone and are not statutory. The independent claims 28 and 51 are directed towards steps of “providing”, “associating”, “transmitting” and “sorting”. Since the claims are directed to a process without including another statutory class of invention (i.e. machine, manufacture, or composition of matter), these claims fall within the scope of human intelligence alone, and are non-statutory.

Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

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As to claims 63-66 and 70, the claims are directed to data signal embodied in a carrier wave. The data signal bearing medium is of non-statutory forms and therefore non-statutory. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 28-39 and 41-70 rejected under 35 U.S.C. 102(b) as being anticipated by Nelson, U.S. patent No. 4,823,265 (reference A in attached PTO-892).

6. As per claim 28, 51, 55, 63 Nelson teaches a method of providing financial accounting statements for a plurality of users, comprising:

providing transaction codes, including standardized codes representing financial transaction information (see Fig. 6, step 101 and step 108; where buyer's code and product code are entered);

each of the users conducting with a plurality of other entities separate financial transactions (see Fig. 1; where plurality of customers conduct separate financial transaction of purchasing renewable option for different securities);

associating at least one of the transaction codes at about the time when funds are transferred or instructions are given for transfer to complete each financial



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transaction (see Fig. 6; where each transaction is represented by buyer's code and code of security type (put/call) for completing buying renewable options);

transmitting a record of each transaction and the at least one transaction code via an open network to at least one file (see Fig. 1 and 4a; where each transaction requested by buyer through terminal is transmitted to central processing system 30 and stored in a data storage); and

sorting the transactions in the at least one file and producing an accounting statement for each user derived from the financial transaction information including income, expense, asset and/or liability information for each user (see Fig. 5b, column 6, lines 26-49).

7. As per claim 29, 52, 56 and 64, Nelson teaches claim 28 as described above. Nelson further teaches the method wherein

the separate financial transactions include the transfer of funds and the instructions for transfer of funds (see Fig. 6A, step 172).

8. As per claim 30, 53, 57 and 65, Nelson teaches claim 28 as described above. Nelson further teaches the method wherein

the at least one transaction code is selected by at least one of the users (see Fig. 6, step 102).

9. As per claim 31, Nelson teaches claim 28 as described above. Nelson further teaches the method wherein

the at least one transaction code is selected by at least one of the other entities ( Examiner notes that it is well known at the time the invention was made transaction

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code is selected by the counterparty such as prepaid phone card where transaction code is established by the phone company).

10. As per claim 32, 54, 58, 66, Nelson teaches claim 28 as described above. Nelson further teaches the method wherein

the standardized codes comprise financial transaction codes (see Fig. 6; step 108).

11. As per claim 33, Nelson teaches claim 28 as described above. Nelson further teaches the method wherein

the transmission of the record of each transaction and at least one transaction code is initiated at about the time when funds are transferred or instructions are given for the transfer of funds (see Fig. 6a; column 9, lines 26-29, 42-44; where transaction is updated when customer accepts the offer).

12. As per claim 34, Nelson teaches claim 28 as described above. Nelson further teaches the method wherein

the transaction codes are provided from a menu (see Fig. 6, step 108; where transaction codes Put or Call selected from the menu).

13. As per claim 35, Nelson teaches claim 28 as described above. Nelson further teaches the method wherein including

entering into said file information regarding at least one of the users (see Fig. 6A, step 172).

14. As per claim 36, Nelson teaches claim 35 as described above. Nelson further teaches the method wherein

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said information includes beginning balances for income, expenses, assets, liabilities and/or bank accounts (see Fig. 5b).

15. As per claim 37, Nelson teaches claim 36 as described above. Nelson further teaches the method wherein

including entering into said file coding information appropriate to at least one of the users (see Fig. 5b; where customer George Nelson transaction for period Jan. 31, 1987 – Feb 28, 1987 is entered into the account statement).

16. As per claim 38, Nelson teaches claim 28 as described above. Nelson further teaches the method wherein

including providing said users and/or agents of said users pass codes to permit access to said at least one file (see column 6, lines 26-30; where account statement is available to customer via different mean including the display; Examiner notes it well known in art of invention that access to information could be restricted by customer requiring to enter pass code).

17. As per claim 39, Nelson teaches claim 28 as described above. Nelson further teaches the method including:

providing a subsidiary ledger for each of said other entities (see Fig. 4a; where transaction by transaction of different customer are recorded in a file which examiner interprets as a subsidiary ledger)and

transferring selected subsidiary ledgers from said other entities to said at least one file (see Fig. 4b; where transaction of specific customer transferred based on

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security owned by the customer which is generated into account statement based on date of transaction as shown in Fig. 5b).

18. As per claim 41, Nelson teaches claim 28 as described above. Nelson further teaches the method including

providing a funds transfer facility to facilitate transfer of funds to and from said users and said other entities (see Fig. 6A, step 172).

19. As per claim 42, Nelson teaches claim 41 as described above. Nelson further teaches the method including:

employing said funds transfer facility to receive an instruction to transfer funds; and transferring funds from at least one of said users to said other entities based on said instruction (see Fig. 6A; when fund is transferred after acceptance is confirmed).

20. As per claim 43, Nelson teaches claim 41 as described above. Nelson further teaches the method including

employing said funds transfer facility to transmit data related to said transfer of funds (see Fig. 6A, step 172; where fund is transferred by debiting buyer's account and updating the account).

21. As per claim 44, Nelson teaches claim 41 as described above. Nelson further teaches the method including

employing said funds transfer facility to adjust current records (see Fig. 6A; column 9, lines 42-43).

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22. As per claim 45, 67, 69 and 70, Nelson teaches a system, method and computer readable medium containing instruction for providing financial accounting statements for a first entity, comprising:

a first computer having at least one file from which an accounting statement may be generated (see Finance Dept. Terminal (42));

a second computer for receiving data inputs, said data inputs including electronically recorded financial -transaction information made between said first entity and a second entity (see Fig. 2, Central Processing System (30), Record Storage (50);

an open communication network for transferring said data inputs from said second computer to said file of said first computer (see Fig. 1, column 3, lines 7-12, 20-24; where different terminal are linked to processing system 20 through data communication link)

means for performing two or more activities selected from the group consisting of entering, deleting, reviewing, adjusting and processing said data inputs, and producing said accounting statement derived from the financial transaction information including income, expense, asset and/or liability information for the first entity (see Fig. 2, Central Processing System (30); column 3, lines 65-67 to column 1-12; column 6, lines 26-31; column 9, lines 43-50).

23. As per claim 46, Nelson teaches claim 45 as described above. Nelson further teaches the system, including:

a first said file in said first computer for receiving accrual accounting data inputs (see Fig. 4c, 4d and 5a); and

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a second said file in said first computer for receiving cash accounting data inputs (see Fig. 5b).

24. As per claim 47 and 68, Nelson teaches claim 45 as described above. Nelson further teaches including

means for transferring funds from said first entity to said second entity (see Fig. 6A, step 172).

25. As per claim 48, Nelson teaches claim 45 as described above. Nelson further teaches the system including

said second computer comprises means for electronically recording, collecting, processing, storing and transmitting said financial transactions (see Fig. 1 and Fig. 2. Central Processing System (30); column 3, lines 65-67 to column 1-12; column 6, lines 26-31; column 9, lines 43-50).

26. As per claim 49, Nelson teaches claim 45 as described above. Nelson further teaches the system wherein

said first computer is a personal computer (see Fig. 1, Finance Dept. Terminal (42) is a personal computer printing billings and statements).

27. As per claim 50, Nelson teaches claim 45 as described above. Nelson further teaches the system wherein

said second computer is a personal computer (see Fig. 1, Central Processing System is personal computer processing input data).

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28. As per claim 59, Nelson teaches an apparatus for producing an accounting statement for a plurality of users comprising:

means for providing transaction codes, including standardized codes representing financial transaction information (see Fig. 1, User Terminal (10); Fig. 6; where each transaction is represented by buyer's code and code of security type (put/call) for completing buying renewable options);

means for each of the users to conduct with a plurality of other entities separate financial transactions (see Fig. 1, securities market database (32); where plurality of customers conduct separate financial transaction of purchasing renewable option for different securities);

means for associating at least one of the transaction codes at about the time when funds are transferred or instructions are given for transfer to complete each financial transaction (see Fig. 1, Central Processing System (30); Fig. 6; where each transaction is represented by buyer's code and code of security type (put/call) for completing buying renewable options);

means for transmitting a record of each transaction and the at least one transaction code via an open network to at least one file (see Fig. 1; User terminal (10) and 4a; where each transaction requested by buyer through terminal is transmitted to central processing system 30 and stored in a data storage); and

means for sorting the transactions in the at least one file (see Fig. 2, Central Processing system (30) and producing an accounting statement for each user derived from the financial transaction information including income, expense, and/or liability

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information for each user (see Fig. 1, Finance Dept. Terminal (42); Fig. 5b, column 6, lines 26-49).

29. As per claim 60, Nelson teaches claim 59 as described above. Claim 60 is rejected under same rational as claim 29 described above.

30. As per claim 61, Nelson teaches claim 59 as described above. Claim 61 is rejected under same rational as claim 30 described above.

31. As per claim 62, Nelson teaches claim 59 as described above. Claim 62 is rejected under same rational as claim 32 described above.

### ***Claim Rejections - 35 USC § 103***

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable Nelson, U.S. Patent No. 4,823,265 (reference A in attached PTO-892) in view of Marks, U.S. Patent No. 5,117,356 (reference B in attached PTO-892).

34. As per claim 40, Nelson teaches claim 39 as described above.

Nelson does not teach providing access to said subsidiary ledger for said users and/or agents of said users, whereby said users and/or agents can perform one or more activities selected from the group consisting of entering, deleting, reviewing, adjusting and processing said data inputs in said selected subsidiary ledgers .



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Marks teaches use of account control table that contain symbolic codes used by record keeping procedure that authorize, control the creation and updating of ledger account and transaction record data files (Marks, abstract).

Therefore, it would be have been obvious to one of ordinary skill in the art at the time the invention was made to add providing access to said subsidiary ledger for said users and/or agents of said users, whereby said users and/or agents can perform one or more activities selected from the group consisting of entering, deleting, reviewing, adjusting and processing said data inputs in said selected subsidiary ledgers of Nelson because Marks teaches that adding above features would enable update ledger using symbolic codes (Marks, column 2, lines 50-57).

### ***Conclusion***

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. Applicant is required under 37 CFR 1.111(c) to consider references fully when responding to this action.

The following are pertinent to current invention, though not relied upon:

Braun et al. (U.S. Patent No. 4,321,672) teach financial data processing system.

Earle (U.S. Patent No. 5,262,942) teaches financial transaction network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571)

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270-1374. The examiner can normally be reached on 7:00AM-4:30PM (Monday-Friday); 2nd Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/  
Supervisory Patent Examiner, Art  
Unit 3691

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05/02/2009